REMARKS

Claim Status

Claims 1-10 are pending in the present application. No additional claims fee is believed to be due.

Rejection Under 35 USC §102 Over U.S. Patent Application 2005/0118119

The Office Action rejects claims 1-4 and 7-10 over Stoltz et al., U.S. Patent Application 2005/0118119 ("Stoltz"). The Office Action states that the reference anticipates the claims insofar as it discloses a skin care composition with an N-acyl amino acid, a skin care active, and a dermatologically acceptable carrier. Applicants respectfully traverse.

The Office Action admits that Stoltz fails to anticipate the present invention, and states on page 6 that "[t]he primary reference [Stoltz] differs from the instant claims insofar as it does not disclose using vitamin B3 as one of the vitamins that may be incorporated into the compositions." Furthermore, a claim is anticipated only if each and every element as set forth in the claim is found. Applicants point out that to be enabling, a reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. *In re Spada*, 911 F.2d 705 (Fed. Cir. 1990). A generic mention of "vitamins" fails to enable the use of one of the hundreds of available vitamins. Applicants further note the requirement of to elect a species from Claim 1, and elected vitamin B3. This implies that vitamin B3 is not equivalent to other vitamins (e.g. retinoids). Applicants therefore respectfully request that this rejection be withdrawn.

Rejection Under 35 USC §103(a) Over U.S. Patent Application 2002/0192169

The Office Action rejects claims 1, 5-6 and 8-10 under 35 USC §103(a) over Chevalier et al (U.S. Patent Application 2002/0192169). Applicants respectfully traverse.

According to *In re Vaeck*, 20 USPQ2d 1438:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Office Action states "[i]n the case of oil in water emulsions, useful emulsifiers include N-acyl amino acids." In fact, N-acyl amino acids are mentioned generically as amphoteric emulsifiers (see [0023]). Applicants state on page 12, line 6 of the instant application that emulsifiers may be nonionic, cationic or anionic. Furthermore, Chevalier fails to teach the use of N-acyl amino acids as a skin lightening agent, no suitable percentages are disclosed, and no examples are given that would teach one of skill in the art the appropriate use therof. Thus, one of skill in the art would not be motivated to modify the reference or would have a reasonable expectation of success.

Applicants further point out that the instant claims require both an N-acyl amino acid and a suitable carrier, which may comprise an emulsifier. By teaching the use of an N-acyl amino acid as an emulsifier, Chevalier also fails to teach all elements of Applicants' instant claims.

Finally, the Office Action states that "it would have been obvious in a self-evident manner to have selected an N-acyl amino acid from one list and vitamin B3 from abother, motivated by the unambiguous disclosure of each individually...". Applicants respectfully and strongly traverse that the disclosure is unambiguous for the reasons stated above, and fail to understand what is meant by "a self-evident manner." Because the Office Action fails to establish any of the three criteria required to show obviousness under 35 U.S.C. 103(a), Applicants request withdrawal of this rejection.

Rejection Under 35 USC §103(a) Over U.S. Patent Application 2005/0118119 in view of 2002/0192169

The Office Action rejects claims 1-10 over Stoltz in view of Chevalier. Applicants respectfully traverse.

The Office Action states ""[I]t would have been obvious to one of ordinary skill of the art to have incorporated vitamin B3 into the compositions of the primary reference motivated by the desire to add a vitamin that could act as an antibacterial agent for the cosmetic compositions...". Applicants believe that this is an improper basis for rejection as Applicants fail to understand the reference to an antibacterial agent. Further clarification is respectfully requested.

Applicants note, however, that in formulating a rejection under 35 U.S.C. 103(a), it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. (Memorandum from Margaret Focarino, Deputy Commissioner for Patent Operations, May 3, 2007.) The Office Action fails to show, however, any motivation for one of skill in the art to combine the references for the reasons discussed above. Applicants therefore request that this rejection be withdrawn.

Conclusion

This response represents an earnest effort to distinguish the invention as now claimed from the applied references. In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. 102(b) and 35 U.S.C. 103(a).

Respectfully submitted,

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